UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,822	04/05/1999	THOMAS A. GRATE	MS1-305US	5476

22801 7590 11/13/2003	**EXAMINER**
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ART UNIT	PAPER NUMBER
2142	15

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DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	**Application No.** 09/286,822	**Applicant(s)** GRATE ET AL.
	Examiner Douglas B Blair	**Art Unit** 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 October 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1.   Claims 1-39 are currently pending in the application.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1, 3, 8, 30, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by

U.S. Patent Number 5,812,669 to Jenkins et al..

4.   As to claim 1, Jenkins teaches a method for establishing a trading relationship between

trading partners involved in electronic commerce, the method comprising: retrieving

configuration details associated with a potential trading partner from a remote site (col. 6, lines

4-42); and automatically configuring a trading relationship with the potential trading partner

using the configuration details (col. 5, lines 40-67).

5.   As to claim 3, Jenkins teaches a method as recited in claim 1, wherein the automatically

configuring comprises: creating a trading partner record (col. 6, lines 4-42); and automatically

populating the trading partner record with the configuration details (col. 6, lines 4-42).

6.   As to claim 8, claim 8 features the same limitations as claims 1 and 3 combined and is

thus rejected on the same basis as claims 1 and 3.

7.   As to claim 30, Jenkins teaches a method for establishing a trading relationship between

trading partners involved in electronic commerce, the method comprising: retrieving

configuration details associated with a first potential trading partner from a remote site by a

second potential trading partner (col. 5, lines 40-67); retrieving configuration details associated

with the second potential trading partner from a remote site by the first potential trading partner

(col. 5, lines 40-67); and automatically configuring a trading relationship with the first and the

second potential trading partners using the configuration details (col. 6, lines 4-42).

8.   As to claim 32, Jenkins teaches method as recited in claim 30, wherein the automatically

configuring comprises: creating a trading partner record; and automatically populating the

trading partner record with the configuration details (col. 6, lines 4-42).

9.   Claims 1-11, 13-17, and 19-29 are rejected under 35 U.S.C. 102(e) as being anticipated

by U.S. Patent Number 6,490,567 to Gregory.

10.   As to claim 1, Gregory teaches a method for establishing a trading relationship between

trading partners involved in electronic commerce, the method comprising: retrieving

configuration details associated with a potential trading partner from a remote site (col. 8, lines

36-52); and automatically configuring a trading relationship with the potential trading partner

using the configuration details (col. 8, lines 53-67).

11.   As to claim 2, Gregory teaches a method as recited in claim 1, wherein the retrieving

comprises addressing a URL to access the configuration details.

12.   As to claim 3, Gregory teaches a method as recited in claim 1, wherein the automatically

configuring comprises: creating a trading partner record (col. 11, lines 13-25); and automatically

populating the trading partner record with the configuration details (col. 11, lines 13-25).

13.   As to claim 4, Gregory teaches an electronic commerce trading system involving

exchanges of commerce information over a network, a method comprising: collecting

configuration details associated with a trading partner participating in the commerce trading

system (col. 6, lines 37-54); and publishing the configuration details to a Web site (col. 8, lines

26-35).

14.   As to claim 5, Gregory teaches a method as recited in claim 4, wherein collecting

comprises presenting a graphical user interface to enable a user to enter the configuration details

(col. 6, lines 37-54).

15.   As to claims 6, 9, 13, 14, 19, 20, 24, 25, 31, 37, and 38, claims 6, 9, 13, 14, 19, 20, 24,

25, 31, 37, and 38 are anticipated by Gregory for the same reasons discussed in the rejection of

claim 2.

16.   As to claim 7, Gregory teaches a method as recited in claim 4, wherein the Web site is

associated with the trading partner (col. 8, lines 26-35).

17.   As to claim 8, claim 8 features the same limitations as claims 1 and 3 combined and is

thus rejected on the same basis as claims 1 and 3.

18.   As to claim 10, claim 10 has the similar limitations as claims 4 and 8 combined and is

thus rejected on the same basis as claims 4 and 8.

19.   As to claims 11, 17, 23, and 34, claims 11, 17, 23, and 34 are anticipated by Gregory for

the same reasons discussed in the rejection of claim 5.

20.   As to claim 15, Gregory teaches a system comprising: a first computer system at a first

trading partner; a second computer system at a second trading partner; a Web site (col. 8, lines

12-67); the first computer system collecting configuration details associated with the first trading

partner and publish the configuration details to the Web site (col. 6, lines 37-54); and the second

computer system retrieving the configuration details from the Web site and automatically

configure for a trading relationship with the first trading partner using the configuration details

(col. 8, lines 10-67).

21.   As to claim 16, Gregory teaches a system as recited in claim 15, wherein the first

computer system hosts the Web site (col. 8, lines 26-35).

22.   As to claims 21 and 26, they have similar limitations to claim 3 and are thus rejected on

the basis as claim 3.

23.   As to claims 22 and 27, they have similar limitations to claim 15 and are thus rejected on

the same basis as claim 15.

24.   As to claims 28 and 29, the limitations for claims 28 and 29 are included in claim 27.

Therefore, the same rejection applies.

Claim Rejections - 35 USC § 103

25.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

26.   Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Number 6,490,567 to Gregory in view of U.S. Patent Number 6,466,940 to Mills.

27.   As to claim 12, Gregory teaches a method of publishing configuration details; however

Gregory does not teach the use of an XML format to publish the details.

Mills teaches the publishing of trading configuration details in an XML format (col. 16, lines 13-55 and col. 17, lines 1-10).

It would have been obvious to one of ordinary skill in the Information Technology art at the time of the invention to combine the teachings of Gregory regarding a trading system with Mills regarding an XML display format because XML provides more extensibility than other display formats.

28. As to claim 18, it is rendered obvious by the Gregory-Mills combination for the same reasons discussed in the rejection of claim 12.

29. Claims 31 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,812,669 to Jenkins et al. in view of U.S. Patent Number 6,490,567 to Gregory.

30. As to claim 31, Jenkins teaches the method of claim 30, however Jenkins does not teach the use of a URL for accessing configuration details.

Gregory teaches a method wherein retrieving configuration details comprises addressing a URL to access the configuration details of trading partners (col. 8, lines 26-35).

It would have been obvious to one of ordinary skill in the Computer Networking art to combine the teachings of Jenkins regarding the configuration of a trading relationship with the teachings of Gregory regarding accessing a URL to retrieve trading configuration details because a URL allows a conventional browser to access the details.

31. As to claim 33, Jenkins teaches a method for establishing a trading relationship between first and second trading partners involved in electronic commerce, the method comprising: collecting first and second configuration details associated with the first and the second trading partners, respectively (col. 20, lines 10-48); publishing the first and second configuration details

(col. 20, lines 49-65); creating, at the second trading partner, a trading partner record for the first

trading partner (col. 20, lines 10-48); creating at the first trading partner, a trading partner record

for the second trading partner (col. 20, lines 10-48); retrieving the configuration details

associated with the first trading partner (col. 20, lines 10-65); retrieving the configuration details

associated with the second trading partner (col. 20, lines 10-65); populating the trading partner

record of the second trading partner with the configuration details associated with the first

trading partner (col. 6, lines 4-42); and populating the trading partner record of the first trading

partner with the configuration details associated with the second trading partner (col. 6, lines 4-

42); however Jenkins does not explicitly teach the use of a Web site to publish and retrieve

configuration details.

Gregory teaches the use of a Web site to publish and retrieve configuration details for a

trade relationship (col. 8, lines 26-35).

It would have been obvious to one of ordinary skill in the Computer Networking art to

combine the teachings of Jenkins regarding the configuration of a trading relationship with the

teachings of Gregory regarding the use of a Web site for accessing configuration details because

a Web site allows a conventional browser to access the details.

32.   As to claim 34, Gregory teaches a method wherein collecting comprises presenting a

graphical user interface to enable a user to enter the configuration details.

33.   As to claim 35, it is rendered obvious by the Jenkins-Gregory for the same reasons

discussed in the rejection of claim 12.

34.   As to claim 36, Jenkins teaches a method wherein publishing comprises the first

configuration details at a first site associated with the first trading partner and the second

configuration details at a second site associated with the second trading partner (col. 20, lines 10-65); however Jenkins does not explicitly teach the use of a Web site to publish and retrieve configuration details.

Gregory teaches the use of a Web site to publish and retrieve configuration details for a trade relationship (col. 8, lines 26-35).

For discussed in the rejection of claim 33 it would be have been obvious at the time of the invention to combine Jenkins with Gregory.

35.   As to claims 37 and 38, Gregory teaches publishing configuration details to a URL and retrieving configuration details from the URL.

36.   As to claim 39, Jenkins teaches a first computer system at a first trading partner; a second computer system at a second trading partner (col. 20, lines 10-65); the first computer system collecting first configuration details associated with the first trading partner and publishing the configuration details to a first site (col. 20, lines 10-65); the second computer system collecting second configuration details associated with the second trading partner and publishing the configuration details to a second site (col. 20, lines 10-65); the first computer system retrieving the second configuration details from the second site and automatically configuring for a trading relationship with the first trading partner using the second configuration details (col. 6, lines 4-42); and the second computer system retrieving the first configuration details from the first site and automatically configuration for a trading relationship with the first trading partner using the first configuration details (col. 6, lines 4-42); however Jenkins does not explicitly teach the use of a Web site to publish and retrieve configuration details.

Gregory teaches the use of a Web site to publish and retrieve configuration details for a

trade relationship (col. 6, lines 37-54).

For discussed in the rejection of claim 33 it would be have been obvious at the time of the

invention to combine Jenkins with Gregory.

Response to Arguments

37.   Applicant's arguments filed 10/20/2003 have been fully considered but they are not

persuasive. The applicant argues the following points: (a) Jenkins fails to teach or disclose

retrieving configuration details from a potential trading partner; (b) It would be unnecessary and

counterintuitive for the methods and system described in Jenkins to configure a trading

relationship with the potential trading partner using the configuration details, since a trading

relationship and configuration details have been established; (c) Information taught by Gregory

is not configuration details associated with a potential trading partner; (d) In Gregory a direct

trading relationship is never established between the merchant party and the purchaser party; (e)

Gregory fails to teach or disclose that the product summary is published to a Web site; (f)

Gregory does not teach that the merchant URL may be used to address configuration details; and

(g) Jenkins does not suggest that trading partners of the user may be trading partners with one

another.

38.   As to point (a), the fact that trading partners have a trading relationship does not exclude

them from being *potential* trading partners. Trading partners that have traded in the past have

the potential to trade in the future.

39.   As to point (b), there is nothing in the claims about configuring a *new* trading relationship. The automation of the exchange of keys is considered automatically configuring a trading relationship with a potential trading partner (columns 5 and 6). The claims are read in light of the specification, but limitations from the specification are not read into the claims.

40.   As to point (c), products offered by the merchant, information regarding the merchant's return policy, forms of payment accepted by the merchant; and information as to ordering products are all considered configuration details. If the applicant wants configuration details to comprise trading partner name, mailing address, Web site address, email, network and data communication protocol(s), cryptographic capabilities and digital certificates, then these limitations should be incorporated into the claim language.

41.   As to point (d), the act of the purchaser party buying something from the merchant party is a trading relationship.

42.   As to point (e), col. 6, lines 25-30 describe the use of a Web Site to publish the merchant's configuration details.

43.   As to point (f), the URL's taught by Gregory contain configuration details as shown in the rejections.

44.   As to point (g), there is nothing in the language of claim 33 that states that trading partners of the user may be trading partners with one another.

Conclusion

45.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

46.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The

examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-746-7239 for regular

communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair
October 31, 2003

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER